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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,417	06/08/2000	Arthur R. Tilford	PD-990142	9701

20991 7590 04/23/2003

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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

2

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

11

<b>Office Action Summary</b>	<b>Application No.</b> 09/590,417	<b>Applicant(s)</b> TILFORD, ARTHUR R.	
	<b>Examiner</b> Scott Beliveau	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "graphical user interface" of claims 11, 20, and 30 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The abstract of the disclosure is objected to because the abstract should be limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

3. Claims 11, 20, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "familiar" is a relative term which renders the claim indefinite as it is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be

reasonably apprised of the scope of the invention. For the purposes of art evaluation, it shall be assumed that the term “familiar” has been redacted from the claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 8-9, 12-13, 18, 21-23, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Wharton et al. (US Pat No. 5,831,664).

In consideration of claims 1-2, 12, and 21-22, the Wharton et al. reference discloses a method, system, and article of manufacture for facilitating communications between a “hand held computing device” [12] inherently comprising a “memory”, a “set top box” [16], and an “output” [14/PDA screen (not labeled)]. Assuming that both the “first” and “second set top box” are the same, as outlined in claim 2, the claimed limitations are met such that the “set top box” [16] is operable to “receive audio/visual information” from the server [18] that was requested by the “hand held computing device” [12]. This information is subsequently “transmitted to” and “stored in” the “hand held computing device” [12]. The claims do not require that the “audio/visual information” is necessarily the same throughout the claim, nor does it explicitly restrict the boundary of “audio/visual information” such that it precludes that the messaging (Figure 4) between the “hand held computing device” [12] and the “set top box” [16] may not be broadly interpreted as a form of “audio/visual information” given

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that it is an informational message pertaining to a request of a particular “audio/visual” presentation or multimedia application. Accordingly, the “hand held computing device” [12] may subsequently “transmit” further “audio/visual information” to the “set top box” [16] wherein the server [18] is operable to provide “audio/visual information” to the “set top box” [16], which is subsequently displayed to an “output device” [14] (Col 3, Lines 26-67 – Col 4, Lines 1-28).

In consideration of claims 3, 11, 13, 20, 23, and 30, the Wharton et al. reference discloses that the information is “transmitted” in response to the depression of “depression of a single button” displayed on a “graphical user interface” (Figure 4) (Col 3, Lines 55-63; Col 6, Lines 19-23).

Claims 8-9, 18, and 28 are rejected wherein the audio/visual information may be displayed on either a “television” [14] (Col 3, Lines 34-36) or on the “hand held computing device” (Col 3, Lines 65-67 – Col 4, Lines 1-5).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10, 19, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton et al. (US Pat No. 5,831,664), in view of applicant’s admitted prior art.

As aforementioned, the reference explicitly discloses the use of a “set top box”, however the reference does not explicitly disclose the “encryption” and “decryption” functionality associated with a “set top box” in a video distribution architecture. The applicant’s admitted prior art discloses that a set top box often utilizes technology that decrypts information that has been transmitted using encryption technology (IA: Page 1, Line 32 – Page 2, Lines 1-2). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Wharton et al. “set top box” [16], if necessary, to further “decrypt” signals which may have been “encrypted” for the purposes of providing a system which prevents the unauthorized usage of distributed video signals.

8. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman (US Pat No. 6,169,879), in view of the PocketTV™ article.

In consideration of claims 1-2, 12, and 21-22, the Perlman et al. reference discloses a method, system, and article of manufacture for facilitating communications between a “set top box” [40] and a VCR [130]. As there is no explicit recitation that the “first” and “second set top box” are the different, the examiner shall presume that they are the same for all dependent claims, as recited claim 2 and 22. The reference discloses that the “set top box” [40] is operable to “receive” and “transmit audio/video information” from/to any of the connected sources including a VCR [130] (Col 9, Lines 23-30, 46-49). The reference further teaches that the VCR [130] is operable to “store” the “audio/video information” from any of the connected sources and to subsequently “transmit” the stored material to the “set top box” [40] for display on an “output device” [110] (Col 9, Lines 58-61).

The reference, however, does not explicitly disclose nor preclude that the aforementioned VCR [130] may not be a “hand held computing device having a memory” as embodied by a PDA. It is arguable that the VCR [130] may be broadly construed as being a hand held computing device, in so far as it is feasible that at some point in time it may be “hand held” while being carried or moved. Assuming arguendo, the Perlman reference suggests that the “set top box” [40] is operable to interconnect any consumer electronic device (Col 6, Lines 43-60). The “PocketTV Brings Video to Palm-size PC” article explicitly discloses that with their software a “handheld or Palm-size PC becomes a miniature VCR”. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a “hand held computing device having a memory” as a VCR as disclosed in the PocketTV™ article in conjunction with the “set top box” [40]/VCR [130] interconnection teachings of Perlman for the purposes of enabling the recording/storage of “audio/visual information” on a device that may advantageously allow for the storage of an entire movie in your pocket (PocketTV™ article).

In consideration of claims 3, 13, and 23, the examiner takes OFFICIAL NOTICE that it is notoriously well known in the art to for a VCR to “transmit the audio/visual information . . . in response to the depressing of a signal button” such as the play button. As aforementioned, the Perlman reference discloses that the VCR [130] is operable to “transmit the audio/visual information” to a “set top box” [40]. Accordingly, given that the suggestion by PocketTV™ article that the PocketTV™ is a “miniature VCR”, it would have been obvious to one of ordinary skill in the art at the time of the invention that it would have a “play button” similar

to other VCRs in the art for the purpose of providing a means for “transmitting audio/visual information” through an interface with which a user of a VCR is familiar.

Claims 4-6, 14-16, and 24-26 are rejected wherein the PocketTV™ article discloses that it is operable to record MPEG based movies. It is well known in the art that a movie such as “The Godfather” may be construed as an “electronic version of a book” which comprises both “audio recordings” and “video clips”.

Claims 7, 17, and 27 are rejected wherein the Perlman reference suggests that the VCR [130] is operable to record a “video game” [164] (Col 9, Lines 58-61).

Claims 8, 18, and 28 are rejected wherein the audio/visual information may be displayed on a “television” [110].

Claim 9 is rejected wherein the PocketTV™ article discloses that the software enables a user to “display the audio/visual information on the hand held computing device”.

Claims 10, 19, and 29 are rejected wherein the Perlman reference suggests that “audio/visual information” may be in an “encrypted form” that is subsequently routed to a “cable box” [122] for “decryption” (Col 10, Lines 50-67). It would have been obvious to one of ordinary skill in the art to modify the “set top box” [40] of Perlman to incorporate the “decryption” functionality of the “cable box” [122] as is known in the art for the purposes of simplifying the operation/interconnection of the system thereby allowing the “set top box” [40] to tune to both scrambled and non-scrambled channels without the need to reroute the signals. Assuming arguendo, the limitation may be met wherein the “first set top box” is the “cable box” [122], and the “second set top box” is the “central electronics device [40].



Claims 11, 20, and 30 are rejected wherein the “transmitting of the audio/visual information” is controlled through a “graphical user interface” such as an EPG displayed on the “output device” [110] (Col 8, Lines 15-21; Col 12, Lines 14-36).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Mcrae (WO 00/19294) reference discloses a portable audio/visual data storage and control unit.
- The Allport (US Pat No. 6,097,441) reference discloses a system and method for using two or more cooperating but physically independent displays for enhanced viewing of data streams.
- The Janky (US Pat No. 5,914,941) reference discloses a digital replacement for an analog audio tape recorder wherein data is transferred through a cable TV broadcasting system.
- The Huang et al. (US Pat No. 6,437,836) reference discloses an embodiment wherein a PDA is operable to control a number of consumer electronic devices.
- The Schulhof et al. (US Pat No. 5,557,541) reference discloses a distribution system for audio program materials including a portable audio storage and retrieval device.

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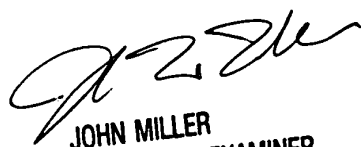
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907.

The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB  
April 16, 2003

  
JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
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